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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/085,081	03/01/2002	Takayuki Yamamoto	220119US0	9114
22850	7590	04/14/2004	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			UHLIR, NIKOLAS J	
			ART UNIT	PAPER NUMBER
			1773	

DATE MAILED: 04/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

10/085,081

Applicant(s)

YAMAMOTO ET AL.

Examiner

Nikolas J. Uhler

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 31 March 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 09 February 2004. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attached sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: It is drawn to the non entered amendment.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.

Claim(s) objected to: none.

Claim(s) rejected: 1-4,6 and 8-11.

Claim(s) withdrawn from consideration: none.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

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**Continuation of box 2:** The proposed amendment will not be entered because it presents a new issues that would required further search and consideration to determine patentability. To be clear a discussion of the applicant's prior arguments is necessary. Specifically, in the declaration filed 10/30/2003, the applicant presented data that allegedly establishes the unexpected results of the invention that arise as a result of the small particle size of the metal salt rust inhibitor. The examiner acknowledges his error in reading the weight % of rust inhibitor of sample 8 as 10.3 mass %. However, even when the correct weight % for sample #8 is considered the declaration is not considered to be persuasive for the following reasons.

First, the declaration is not commensurate in scope with the claims. The data presented by the applicant only establishes that one specific rust inhibitor, Calcium Phosphate, has the asserted particle size effect. However, the instant claims are open to a much broader class of rust inhibitors, namely all rust inhibitors that are more base than zinc. This one example cannot be said to establish the unexpected results for the potentially limitless number of rust inhibitors that are more base than zinc.

Second, the declaration is inconclusive at best when viewed with regard to the other data in the specification. Applicant's examples 9 and 12-13, as presented in Table 1, "appear" to establish that reducing the particle size of calcium phosphate has some impact on the properties of the anti-corrosive film, with samples having a particle size  $<1\mu$  having better corrosion resistance. However, samples utilizing magnesium phosphate clearly do not exhibit the same improved corrosion resistance though the rust inhibitor has the required particle size. Further, samples 1 and 6, which utilize

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aluminum phosphomolybdate, do not support the applicant's argument of unexpected results. The table below (data is copied exactly from the table 1) helps clarify this point.

Sample	Rust inhibitor	Average particle diameter	Amount used	Pitting resistance	Red Rust resistance	Corrosion resistance after coating
1	Aluminum phosphomolybdate	.38 $\mu$	5.83 mass %	A	A	<b>B</b>
6	Aluminum phosphomolybdate	.46 $\mu$	5.66 mass %	A	A	A

As can be seen, sample #1 has **worse** corrosion resistance than example # 6, though it is similar in most respects to sample #6 aside from the fact that it has a smaller particle size. Thus, as the applicant's data conflicts between samples and types of rust inhibitors, it is not persuasive.

Bearing the above in mind, applicant's proposed amendment to insert the limitations of claim 6 into claim 1 does not render the case allowable. Further, while the combination required by the proposed amendment is not a new combination, the amendment would create a number of new combinations that would require further search and consideration to determine patentability, as claims 2-4 and 8-11 never before required the limitations of claim 6. Thus, the proposed amendment will not be entered because it presents new issue that require further search and consideration to determine patentability and because it does not materially simplify the issues for appeal.

MU

  
Paul Thibodeau  
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Technology Center 1700